

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROBERT F. GEHAN
and ZEINAB M. ALI

Appeal 2006-3314
Application 09/761,322
Technology Center 1700

Decided: January 4, 2007

Before CHUNG K. PAK, CATHERINE Q. TIMM, and LINDA M. GAUDETTE, *Administrative Patent Judges*.

GAUDETTE, *Administrative Patent Judge*.

DECISION ON APPEAL

This appeal involves claims 1-13, the only claims pending in this application. We have jurisdiction over the appeal pursuant to 35 U.S.C. § 134.

INTRODUCTION

The claims are directed to a novelty cookie product. Claims 1, 4, and 8 are illustrative:

1. A novelty cookie product comprising a base cake having a three-dimensional image thereon and a layer of confection covering at least a portion of the image, thereby forming a latent image that can be revealed by removing at least a portion of the confection.

4. A cookie product according to claim 1 wherein the image on the base cake is formed by rotary molding to have a pattern of lands and recesses such that the confection, when partially removed at least partially fills in the recesses while it is removed from a portion of the image to make the image visible to a consumer.

8. A method of making a novelty cookie product comprising baking a base cake having a three-dimensional image thereon and applying thereto, over the image, a layer of confection to cover at least a portion of the image, thereby forming a latent image that can be revealed by removing at least a portion of the confection.

The Examiner relies on the following prior art references to show unpatentability:

| | | |
|----------|-----------------|---------------|
| Persson | AUS 224485 | Feb. 26, 1959 |
| Pappas | US 5,534,281 | Jul. 9, 1996 |
| Blaschke | US 6,312,743 B1 | Nov. 6, 2001 |

The rejections as presented by the Examiner are as follows:

1. Claims 1-3, 5-9, and 11-13 are rejected under 35 U.S.C. § 103(a)

as unpatentable over Persson and Blaschke.

2. Claims 4 and 10 are rejected under 35 U.S.C. § 103(a) as

unpatentable over Persson in view of Blaschke and further in view of

Pappas.

OPINION

Claims 1-3, 5-9, and 11-13 are rejected under 35 U.S.C. § 103(a) as unpatentable over Persson and Blaschke. Claims 4 and 10 are rejected under 35 U.S.C. § 103(a) as unpatentable over Persson in view of Blaschke and further in view of Pappas.

The Examiner relies on Persson for a disclosure of a sugar confectionery having a printed picture on the surface. The picture is placed in a depression in the surface of the confectionery and covered with an opaque coating which can be licked off by the consumer to reveal the picture. (Answer 3). The Examiner concedes that Persson differs from the present invention in that it is a sugar confectionery and not a cookie. (Answer 4). However, the Examiner maintains that it would have been obvious to change the substrate in Persson from a candy to a cookie in view of Blaschke's disclosure of a ready-for-use cookie dough provided with score lines or grooves that define equally sized portions to be broken off and baked. (Answer 4). The Examiner relies on Pappas for a teaching of using rotary molding to form designs on foods such as cookies, crackers and' snacks. (Answer 5).

Appellants argue, inter alia, that Persson's picture is flat, i.e., two-dimensional, and covered with a uniform coating. Therefore, Appellants maintain that the Examiner's proposed combination fails to disclose or suggest a three-dimensional image as required by the present claims. (Br. 6).

The Examiner, however, takes the position that Persson discloses a three-dimensional image as claimed because the picture, when placed in the surface depression, "gives the image an illusion of depth." (Answer 6).

Patentability begins with the legal question “what is the invention claimed?” *See Panduit v. Dennison Mfg. Co.*, 774 F.2d 1082, 1093, 227 USPQ 337, 344 (Fed. Cir.1985). During examination, patent claims must be given their broadest reasonable interpretation consistent with the specification. However, claim language cannot be read in a vacuum, but instead must be read in light of the specification as it would be interpreted by one of ordinary skill in the pertinent art. *See In re Sneed*, 710 F.2d 1544, 1548, 218 USPQ 385, 388 (Fed. Cir.1983). In our view, the Specification clearly sets forth that which Appellants intended to encompass by the claim language “three-dimensional image,” i.e., an image which itself is three-dimensional such as an intaglio (*see, e.g.*, Fig. 2), as opposed to a two-dimensional image such as printed matter on a surface, even if given the illusion of being three-dimensional.

Accordingly, we reverse the Examiner’s rejection of claims 1-13 under 35 U.S.C. § 103 because it is based on an erroneous interpretation of the claim language.

REMAND TO THE EXAMINER

While we have not sustained the Examiner's rejections for the reasons stated above, it appears to us that the propriety of rejections under 35 U.S.C. §§ 102 and 103 should be evaluated by the Examiner in view of at least the following additional references:

| | | |
|------------|--------------|---------------|
| Gerstman | Des. 298,180 | Oct. 25, 1988 |
| Concepcion | Des. 298,280 | Nov. 1, 1988 |
| Tabor | Des. 306,790 | Mar. 27, 1990 |
| Boehm | US 4,948,602 | Aug. 14 1990 |

Boehm teaches that it was known in the art at the time of the present invention to enrobe filled cookies such as OREO® cookies in a chocolate or fudge coating. Boehm, col. 1, l. 67- col. 2, l. 7. *See* <http://www.kraft.com/100/innovations/oreo.html> (OREO® cookies were first introduced in 1912. Fudge Covered OREO® cookies were introduced in the 1980's).¹ *See also* Appellants' Specification, p. 1, ll. 11-15 ("Sandwich cookies [sic] are well known and are available commercially under a number of names including OREO®, NUTTER BUTTER®, SNACKWELL'S® and many others.") The base cake of an OREO® cookie is a baked product containing a three-dimensional image² thereon. The chocolate or fudge coating is a layer of confection covering the image. Removing a portion of the outer coating would at least partially reveal the image.

¹ OREO® cookies were first introduced by Nabisco. http://www.kraft.com/100/timeline/time_1910s.html. Philip Morris Companies Inc., Kraft Foods' parent company, acquired Nabisco Holdings in 2000 at which time the Nabisco brands were integrated into the Kraft Foods business. http://www.kraft.com/100/timeline/time_2000s.html. Kraft Foods Holdings, Inc. is said to be the real party in interest in the present appeal Br. 2.

² We note that appealed claims 6, 7, and 12 recite specific three-dimensional images. Where claimed features of patent utility claims relate to ornamentation only and have no mechanical function whatsoever, they cannot be relied upon for patentability. *See In re Seid*, 161 F.2d 229, 231, 73 USPQ 431, 433 (CCPA 1947).

Gerstman, Concepcion and Tabor³ disclose ornamental designs⁴ for a cookie comprising a base cake having a three-dimensional-image thereon and a layer of confection covering at least a portion of the image, thereby forming a latent image that can be revealed by removing at least a portion of the confection. Gerstman and Concepcion also disclose a top layer having a three-dimensional image formed thereon.

This Remand to the Examiner pursuant to 37 C.F.R. § 41.50(a)(1) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)) is made for further additional prior art findings and further consideration of a rejection consistent with our interpretation of the claim language.

REVERSED and REMANDED

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³ These patents, like the present application, appear to have been assigned to Nabisco Brands, Inc./Kraft Food Holdings at the time of filing of the present application.

⁴ See *In re Aslanian*, 590 F.2d 911, 914, 200 USPQ 500, 503 (CCPA 1979) ("[T]he specific disclosure of structure in a design patent application may inherently teach functional features."). See also, *In re Meng*, 492 F.2d 843, 847, 181 USPQ 94, 97 (CCPA 1974)(a claimed invention may be anticipated or rendered obvious by a reference drawing).